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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,066	09/19/2006	Ludwig Brehm	1093-162 PCT/US	3721

23869 7590 09/26/2008  
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EXAMINER
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GRABOWSKI, KYLE ROBERT

ART UNIT	PAPER NUMBER
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3725

MAIL DATE	DELIVERY MODE
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09/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,066	<b>Applicant(s)</b> BREHM ET AL.	
	<b>Examiner</b> Kyle Grabowski	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/19/06, 08/15/07, 09/10/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: The optical separation layer 25 is incorrectly referenced as 24 (Pg 10, 31).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation that the sealing layer covers at least 80% of a surface of the film element contradicts the drawings and specification. The only way the sealing layer can “cover” the film element is through a window (see Figure 2), however these windows do not cover a substantial area of the film element, perhaps only 20% as shown (see Figure 1). This discrepancy renders the claim indefinite. For prosecution on its merits however, the claim will be construed to mean *wherein the sealing layer has a surface area of at least 80% the surface area of the film element* (This interpretation is congruent with claim 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 9-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber (US 6,036,230) in view of Hseih et al. (US 2005/0153113) and Keller et al. (US 2005/0104364).

In respect to claims 1, 4, and 6-8, Farber discloses a security document comprising a paper support 1 having window-shaped openings 2 which are closed by a transparent film element 3 which projects beyond the openings on all sides; opposite the film element 3 is an identical sealing layer 3 on the paper support 1 (Fig. 4); the film element 3 may contain an additional security feature (Col. 2, 6-10). Farber does not specifically disclose that the additional security feature is an *optical* security feature or

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that the sealing layer 3 comprises a lacquer which is applied by a screen printing process resulting in a lacquer layer 2 to 10  $\mu\text{m}$  thick.

Hseih et al. teach applying a protective lacquer layer 63 with a thickness of 2 to 10  $\mu\text{m}$  (0073) via a screen printing method (0077) and it would have been obvious to one of ordinary skill at the time the invention was made to provide the sealing layer taught in Farber by a screen printing method in view of Hseih et al. to provide a sufficiently thick lacquer layer that screen printing enables (Hseih et al, 0077). Furthermore, the patentability of a product does not depend on its method of production (MPEP 2113, R-1)

Keller et al. teaches a similar security 1 document having windows 2 which are covered by a film element 3, which comprise optically variable security features (0005-0006, Fig 2 & Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the security features taught in Farber as optically variable devices in view of Keller et al. to provide forgery-proofness having a visually recognizable appearance (human observable) (Keller et al., 0004-0005)

In respect to claims 2 and 3, Farber further discloses that the sealing layer may be the upper film layer 3 and the film element may be the lower film layer 3 (Fig. 4); in this instance, the upper sealing layer 3 appears to have 100%-120% of the area of the lower film element 3. Although the disclosure does not explicitly state this range, it would have obvious to one of ordinary skill in the art at the time the invention was made to provide a sealing layer that is the same size or slightly larger than the film layer to

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ensure adequate sealing. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art.

In respect to claim 5, Keller et al. further teach providing the film element 3 with additional security features in the form of printed images (0007).

In respect to claims 9-13, Farber further disclose that the sealing layer 3 and film element 3 are comprised of the same plastic material. Thus it follows that the sealing layer, which comprises the lacquer layer, and the film element have the same expansion coefficient and moduli of elasticity –which are inherent properties of the material, whichever plastic material is chosen.

In respect to claims 14-16, Farber as modified by Hseih et al. and Keller et al. disclose the claimed subject matter for the reasons stated above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Herrmann et al. (US 2002/0030360), Heim (US 2005/0127663), Hardwick et al. (US 2002/0027361), Moreau (US 2007/0029784), Antes et al. (US 5,714,213), and Bohm et al. (US 6,343,745) disclose similar inventions.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/  
Supervisory Patent Examiner, Art  
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/Kyle Grabowski/  
Examiner, Art Unit 3725